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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,895	03/12/2001	Junichi Tsuji	Q63336	6637

7590 11/03/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
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EXAMINER	
THOMPSON, JAMES A	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/802,895	Applicant(s) TSUJI, JUNICHI	
	Examiner James A. Thompson	Art Unit 2624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-9 and 14-26*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 14 September 2005 have been fully considered but they are not persuasive.

Regarding page 2, line 1 to page 4, line 4: Applicant is correct in stating that the references must be considered as a whole as to what they would teach or suggest to one of ordinary skill in the art and that Examiner cannot simply pick and choose among individual parts of assorted prior art references as a mosaic to recreate the claimed invention. However, Applicant must also recognize that, so long as a rejection takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Applicant's disclosure, a reconstruction of the claimed invention from the prior art references is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the case of the previous rejection, dated 12 May 2005, Nakamura (US Patent 5,684,262) has been relied upon for its teachings with regard to a voice tone converter (column 5, lines 38-41 of Nakamura). The primary reference, Bell (US Patent 5,276,472), teaches the recording and printing of audio data in association with a printed photograph (column 4, lines 4-6 and lines 29-34; and column 5, lines 30-35 of Bell). While the purpose of the tone converter taught by Nakamura may be for aiding in the combination of sounds, as Applicant alleges, tone conversion can still clearly be performed on a single sound recording, such as the sound recording taught by Bell. This is common practice in audio recording since sound levels should be

within a particular range such that said sound levels are loud enough to be heard, and can utilize the available dynamic range without saturating the sound levels, thus providing an optimal playback. While Nakamura may have additional functions and possibly even more complicated features than may required for implementation into the Bell reference, the basic tone conversion functions can nevertheless be implemented into the Bell reference. Although the genre of a musical piece is not particularly relevant to the system taught by Bell, this is simply an example of the intended use in Nakamura of said tone converter. The tone converter does not *have* to be used in relation to a karaoke system. A tone converter simply modifies the input or output sound waves to produce a resultant signal.

As stated on page 8, lines 12-22 of said previous rejection, one of ordinary skill in the art at the time of the invention would have been motivated to combine the teachings with regard to the tone converted of Nakamura with the system of Bell since the tone converter allows one to control the tone level based on the input level (column 5, lines 41-47 of Nakamura), thus improving the resultant audio signal recorded by the system of Bell. Since *only* the prior art references have been relied upon for the relevant teachings and motivation, the reconstruction of the claimed invention from the references is a proper reconstruction, and not hindsight reconstruction.

Furthermore, Nakamura is not, as Applicant alleges, non-analogous art. Bell teaches the electronic recording and processing of audio data. Nakamura also teaches the electronic recording and processing of audio data. One of ordinary skill in the art at the time of the invention would clearly see the relationship between these two prior art references since both

references are simply different systems for the modification of electrical signal impulses which are used to generate sound waves. To use an analogy, it is in many respects the same way in which a cassette recorder and an equalizer are analogous art. The cassette recorder records and plays back sound while the equalizer modifies the electrical impulses to produce a modified recording or playback.

Regarding page 4, lines 5-14: While it is true that the Bell references does not discuss tone-conversion, the teaching or suggestion with regard to tone-conversion need not be limited solely to the Bell reference. As discussed above and in said previous rejection, the teachings with regard to tone-conversion are given in Nakamura, along with adequate motivation to combine the references. It is by the *combination* of Bell and Nakamura that tone-conversion is performed on the audio data that is to be printed. Again, it is not required that the suggestion to combine come from the primary reference. In fact, if such a modification were taught by Bell, then there would be no need to combine the references. If there were a requirement that the teachings or suggestions with regard to each and every component must come from the primary reference, then the whole concept of the combination of references under 35 USC §103(a) would be rendered meaningless since all components would therefore have to be taught by the primary reference.

Regarding page 4, line 15 to page 5, line 5: *Applicant argues* that, since Nakamura goes into depth regarding the methods of modifying a voice signal, the insertion of an additional audio process is not trivial.

Examiner responds that Nakamura goes into depth about the details of the audio process itself. Nakamura does not go into

detail about how exactly to place an audio process into the sound processing circuitry. Given an audio modification processing circuit, one simply needs to place the circuit in series with the other sound processing devices to provide an additional filtering and/or modification to the sound to produce the desired result. The tone converter, for example, can be placed after the analog amplifier as part of the overall data processing, thus modifying the tone before the audio data is output.

Regarding page 5, lines 6-19: Again, Nakamura teaches in detail the specifics of the audio processing the system of Nakamura performs. While the creation of new and improved audio processing functions is clearly not trivial, the addition of audio processing steps *already given* is a trivial matter to one of ordinary skill in the art at the time of the invention. Nakamura teaches those new and improved audio processing functions. The addition of said functions *already given* by Nakamura to the system taught by Bell is what would be trivial to one of ordinary skill in the art at the time of the invention. Examiner has not suggested that the creation of the audio processing functions taught by Nakamura is trivial, it is merely their inclusion into the system of Bell that would have been trivial to one of ordinary skill in the art at the time of the invention. Furthermore, as with Nakamura, it is the *addition* of the small audio processing steps already taught by Leveque (US Patent 5,495,468) to the system of Bell in view of Nakamura that is trivial, not the steps themselves. The steps themselves are taught by Leveque, and thus would be accessible to one of ordinary skill in the art at the time of the invention.

Regarding page 6, lines 1-18: There is, in fact, speech data prior to conversion. The cited portion of Leveque states that a "plurality of voice signals $V_1,\ldots,V_N$ are input to corresponding Lincomplex compressors $LPXC_1,\ldots,LPXC_N$, where N is an integer greater than or equal to two" [column 5, lines 2-4 of Leveque]. Furthermore, though the transmission medium taught by Leveque is not the same transmission medium taught by Bell, one of ordinary skill in the art at the time of the invention could easily have applied the teaching of Leveque to a different transmission medium, such as the printer taught by Bell. In both cases, it is a simple matter of transmitting an electrical signal corresponding to particular data. In Bell, the transmission provides data to the printer. In Leveque, the data is transmitted wirelessly. The combination is thus well within the abilities of one of ordinary skill in the art at the time of the invention. The motivation one of ordinary skill in the art at the time of the invention would have to combine Leveque with Bell in view of Nakamura has been given on page 11, lines 16-20 of said previous rejection. As can be seen, the motivation is found within the Leveque reference itself, as are the relevant teachings. Thus, since only the prior art available to one of ordinary skill in the art at the time of the invention has been relied upon to teach the claimed invention, and Applicant's disclosure has not been relied upon, the reconstruction of the claimed invention is clearly not the result of any impermissible hindsight.

Regarding page 7, lines 1-5: Claims 17 and 18 are alleged to be patentable due to their dependency from claim 14. Since claim 14 has been shown to not be patentable over the prior art and claims 17-18 have been rejected based on prior art in said

previous rejection, claims 17-18 are therefore not deemed to be patentable.

Regarding page 7, lines 6-20: The quote from Bell cited by Applicant does not, in fact, teach away from a combination with Hatada (US Patent 4,270,853), though it may appear so at first. The quote from Bell relates to a problem with "the photographic film systems *described above*" [emphasis added]. The photographic systems referred to by Bell are particular photographic systems taught in specific US Patents (column 1, lines 12-17 of Bell), and should not be construed to relate to all possible photographic systems. In fact, the system of Bell provides a magnetic recording layer associated with the film (figure 3(13) of Bell), which is later used for the print. Thus, *later* printing the picture with an associated magnetic strip requires only a modification of what is already taught by Bell, namely the replacement of the barcode printing with magnetic strip printing, with the required audio data taken from the magnetic strip already on the developed film. Furthermore, it cannot be true that only instant print cameras can have magnetic strips associated with a printed picture since, if such were true, then Applicant's own invention as set forth in claim 19 would not function for the same reason.

Regarding page 8, lines 1-17: While the system taught by Bernardi (US Patent 5,692,225) uses the speech originally recorded by the user, the *combination* of Bernardi with Bell in view of Nakamura allows for tone conversion, as taught by Nakamura. Bernardi is relied upon for the teachings with regard to the speech-to-text converter and the text recorder. The relevant audio signal is the signal recorded according to the teachings of Bell in view of Nakamura. Thus, the alleged

problem of the speech being difficult to understand would not exist in the resultant system taught by the combination of references.

Regarding page 8, line 18 to page 9, line 7: The claims upon which claims 8, 23 and 25 depend have been demonstrated to be unpatentable and claims 8, 23 and 25 have also been shown in said previous rejection to be unpatentable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

21 October 2005

[illegible]
[illegible] EXAMINER